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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,716	11/13/2001	Jonathan S. Stinson	23,369-134	5960

23452 7590 11/23/2005

PATENT DEPARTMENT
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EXAMINER

BARRETT, THOMAS C

ART UNIT PAPER NUMBER

3738

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,716

Applicant(s)

STINSON ET AL.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-53, 56-60, 64-68 and 71-86 is/are pending in the application.
- 4a) Of the above claim(s) 45, 47-49, 52, 79 and 86 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 83-85 is/are allowed.
- 6) ☒ Claim(s) 35-41, 44, 51, 53, 56-58, 64, 65, 71-73, 75 and 81 is/are rejected.
- 7) ☒ Claim(s) 42, 43, 46, 50, 59, 60, 66-68, 74, 76-78 and 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 45, 47-49, 52, 79 and 86 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 12, 2005.

The Applicant traversed the restriction on the grounds that the generic claim is allowable, however the Examiner feels the generic claim is not allowable as discussed in the below rejection.

Response to Arguments

Applicant's arguments with respect to claims 35-44, 46, 50-51, 53, 56-60, 64-68, 71-78, 80 and 83-85 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the prior art fails to disclose the marker attached to the endoprosthesis "to improve a radiopacity of the endoprosthesis", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Please note that the Applicant listed claim 35 as cancelled. Because other claims are dependent on claim 35, it is assumed for prosecution that this is a typographical error and claim 35 has been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-41, 44, 51, 56-58, 64-65, 71 and 81 are rejected under 35

U.S.C. 103(a) as being unpatentable over Hillstead (5,019,085) in view of Pinchuk (5,019,090). Hillstead discloses a stainless steel band for retaining a stent on a delivery device (col. 3, lines 24-30) having a loop at its end for withdrawal (Figure 1) however Hillstead fails to disclose the band retaining a less radiopaque stent. Pinchuk teaches a polypropylene stent (col. 7, lines 14-17). It would have been obvious to one of ordinary skill in the art to combine the teaching of a polypropylene stent, as taught by Pinchuk, to a delivery device comprising a stainless steel retaining band as per Hillstead, the motivation to combine being "The stent is fabricated in accordance with techniques disclosed in co-pending U.S. patent application Ser. No. 240,000 filed Sept. 1, 1988 entitled "Radially Expandable Endoprosthesis and the like" which is assigned to the Corvita Corporation", as found in Hillstead (col. 3, line 65- col. 4, line 1). U.S. patent application Ser. No. 240,000 is now U.S. Patent 5,019,090.

Claims 53 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillstead (5,019,085) in view of Myler et al. (5,474,563). Hillstead discloses a stainless steel band for retaining a stent on a delivery device as above, however Hillstead fails to disclose the band having an average thickness of from about 20 to

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about 500 microns. Myler et al. teaches the use of about 500 microns thick stainless steel wire, which is radiopaque (col. 9, lines 6-11). It would have been obvious to one of ordinary skill in the art to combine the teaching of the use of about 20 microns thick stainless steel wire, as taught by Myler et al., to the system as per Hillstead, in order to make it radiopaque. Please Note: 0.0015 inch = 38.1 micron.

Claims 72-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillstead (5,019,085) in view of Pinchuk (5,019,090), in further view of Myler et al. (5,474,563). Hillstead discloses a stainless steel band for retaining a stent on a delivery device as above, however Hillstead fails to disclose the band having an average thickness of from about 20 to about 500 microns. Myler et al. teaches the use of about 500 microns thick stainless steel wire, which is radiopaque (col. 9, lines 6-11). It would have been obvious to one of ordinary skill in the art to combine the teaching of the use of about 20 microns thick stainless steel wire, as taught by Myler et al., to the system as per Hillstead, in order to make it radiopaque.

Allowable Subject Matter

Claims 42-43, 46, 50, 59-60, 66-68, 74, 76-78 and 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 83-85 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Thomas Barrett", with a stylized flourish at the end.

Thomas Barrett
Examiner
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